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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/019,481
Filing Date: April 04, 2002
Appellant(s): TAKAGI ET AL.

MICHAEL P. BYRNE
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/5/08 appealing from the Office action mailed 8/22/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

I. The rejection over TREACY et al is under 35 U SC 102 (e) only.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner;

II. The rejection over Treacy under 35 USC 102(a).

III. The rejection over TREACY et al in view of TAKAGI et al & STEFFERUD

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6342518	TREACY	1-2002
5543573	TAKAGI	8-1996

STEFFERUD, ed. HOUSEHOLD INSECTS in YEARBOOK OF AGRICULTURE , 1952, p. 469

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1, 13-16,18 -47 stand rejected under 35 U.S.C. 102(e) as being anticipated by TREACY

Treacy has priority to US provisional application filed 3/12/99 , although Treacy was published after Appellant's US filing date Treacy's US priority date predates appellant's claim to priority based on Japanese application 11/190671 of 7/5/99.

TREACY is stated to be commonly owned at the time of filing of the instant, & so is available under 35 USC 102(e).

Instant Claim 1 recites " A method for controlling a pest selected from the Isoptera, Hymenoptera, Orthoptera, and Psocoptera orders which comprises applying to said pest or to a wooden part or to soil in the habitat of said pest an effective amount of a hydrazine compound of formula (1): The specific, most limiting presentation of (I-1) is the compound of claim 13, which is also the elected & the preferred compound (page 5, lines 25-31) . All other claims are less limiting than claim 13. Independent claims 15 & 16 recite the formula (I-1) as in claim 1.

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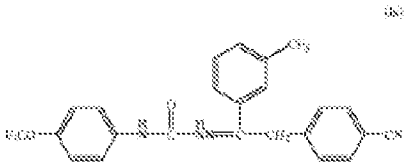
Treacy provides methods for insect control (col. 1, lines 44-46) by application to crops & insect habitats (col. 7, lines 9-12,17-25) of effective amounts of particularly preferred compound Ia (col. 8 & claim 11).



Insects controlled are inclusive of ants (Formicidae family of the Hymenoptera order) & termites (the order Isoptera) at col. 7, lines 33-35.

Claim 11, dependent on claim 10 of TREACY denotes the same specification of the moeities of the formula (I) compound of claim 7, which is the identical compound of appellant's claim 13, but claim 7 recites "a method for synergistic insect control which

comprises contacting said insect with a synergistically effective amount of a combination of a neuronal sodium channel antagonist compound of the formula (I) - ".

The contacting of insects of TREACY is seen as the controlling of pests selected from Isoptera --- Psocoptera which comprises APPLYING the compound of formula (I) of Appellants.

Compound I-1 of the instant invention, in its most limiting & definitive preferred form , (page 5, lines 25-31 of the instant specification, & as recited at claim 13) is identical to compound (Ia) of Treacy (col. 8) who states it may be used to control Cockroach, ants, termites or the like (col. 7, lines 32-35). Application is to plant (crop) foliage or insect habitat (col. 7, lines 9-12). Claim 11 of Treacy, & compound (1a) meet all the instant compounds of claims18-47, drawn to various specific moieties of formula I-1 .

The language of instant independent claims 15 & 16 differ from claim 1 in that the Isoptera , termites, are limited to 4 families (Claim 15) and at claim 16 to the ant family, Formicidae of the Hymenoptera order.

The termite families are common, & we see them included in Treacy's generic Termites. Treacy's ants are seen as included in the ant family, Formicidae.

Claim1, 10, 13-47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over STEFFERUD in view of TAKAGI et al

Stefferud is an old reference identifying the insect pests of the instant as well known household insect pests. Stefferud at Page 469 shows household insect pests which need to be controlled include those which invade homes & attack wood, & are inclusive of the instant orders of claim 1 termites- ISOPTERA and , ants - HYMENOPTERA at paragraph 2, of cockroach & cricket(ORTHOPTERA) at paragraph 3 & psocids (PSOCOPTERA) at paragraph 4. Others as household pests are powder post beetles (paragraph 2), flies & mosquitoes (paragraph 4). Stefferud is not cited for the particular compounds applied to the household habitats. Stefferud used DDT & CHLORDANE, pesticides of old, now considered too toxic for household use.

TAKAGI does disclose compounds that can control a wide variety of insect pests, inclusive of the instant species. TAKAGI shows 14 examples of tested compounds, one of which, at example 14 (col. 61) is the elected species & most limiting of the instant claimed compounds – that of the instant claim 13 & designated compound 261 at the instant disclosure at tables 7& 8. Takagi applies the insecticides to control insects at the instantly claimed application sites: inside houses (col. 63, lines 9-17), & to soil, trees & crops, the habitats of various sanitary & horticultural insect pests (col. 62, lines 8-12, 44,60) inclusive of some of the household insects cited by Stefferud- powder post beetles, flys & mosquitoes. These application sites are the subject sites of instant

independent claims 1- wooden parts or soil, claim 15, a habitat or place at which occurrence of said pest is expected, & claim 16- to pests, crops or soil- .

Application rates are 0.01-50% of compositions (col. 64, lines 32-38) & @ 0.1- 5 kg/10 acres (col. 64, lines 38 – 56), as is desired & under conditions determinable by artisan in accord with known factors of consideration in effecting control of insect pests.
Although ant and termite are not specifically recited, the method steps, applying the instant compounds to the instant habitats & application sites (instant claim 1, a wooden part, or soil, instant claim 15, applying to protect a house,instant claim 16-applying to crops, soil) at the instant rates would result in the same control as of the instant invention as claimed, resulting in powder post beetle, mosquito, fly & sanitary Insect control, as recited by TAKAGI, & also in control of the equivalent associated household pests identified by Stefferud ; termites—as required of instant Claims 10 & 15 and of claim 16 , which requires ant control.
The particular families of termites & ants are commonly found as household pests, & the Generic inclusion of ants & termites would be inclusive of these families, thus inclusive of the species of the generic concept, in this case inclusive of the families of termites Rhinotermitidae, & of ants Formicidae ,of instant claims 10,15 &16
It would have been obvious to a person of ordinary skill in the art at the time the invention was made desiring to utilize pest control means to control household insects, as identified by Stefferud to include flies, ants, termites, psocids & powder post beetles,

to use one of the exemplified Takagi formulations shown to have marked effectiveness (col. 63, lines 7-22) to control agricultural, forest insect, horticultural, & sanitary insect pests, when applied to trees, fields, inside of houses & ditches around houses ,at low doses. The substitution of Takagi ‘s pesticide for the too toxic DDT & chlordane at the time of Stefferud would have been an obvious one at the time of the instant invention, as although Stefferud's pesticides are no longer accepted, the common household pests still need to be treated at their habitat's as shown by Steffrud.

The particular amounts and proportions of each ingredient are result effective parameters chosen to obtain the desired effects. The one of ordinary skill in the insecticide arts would have found it obvious to utilize a favored compound, one of the 14 exemplified, to test for efficacy against the particular household insect pest of concern, in order to determine the optimal compound and concentration to use , & have expectation of success, in consideration of the 2007 supreme court decision in KSR V TELEFLEX @ 82 USPQ 2d @ 1385.The 14 exemplified compounds of the art were known to have broad insecticidal effects on a large range of related and unrelated household pest insects as taught by Takagi. Given the demonstrated broad application efficacy of the art exemplified compounds, one of ordinary skill in the art could have pursued the known potential options of use on other common household insect pests with a reasonable expectation of success. The person of ordinary skill in the art would have good reason to pursue the art known broad insecticidal compounds to control and protect against common insecticidal pests. That such pursuit leads to success does not render it nonobvious.

Appellant has not provided any objective evidence of nonobvious or unexpected results that the administration of the particular compounds of the elected species provides any greater or different level of prior art expectation as claimed. The Takagi example chosen for comparison in the Declaration of 2006 was not one of the14 exemplified compounds, but rather one of the 400 or so of TABLE 7. The compound of TAKAGI 'S example 14 , compound 261 in TABLE 7, was 100% effective at rates of 500 ppm against cutworm,or 200 ppm (TABLE 8), against weevils.

This compound was shown effective in the Declaration at 300 & 3000 ppm against Argentine & harvester ants.

(10) Response to Argument

I . Appellant argues Treacy does not show exactly what is claimed, & generic disclosure does not establish anticipation of the claimed subject matter.
Examiner finds while Treacy is generic to insect control, ants & termites are specifically included. Further, the claimed compounds, including that preferred, are applied to the same habitats of the same insects as are instantly claimed, thus meeting the active steps of the claimed invention.
Appellant argues Treacy is prophetic, in the use of MAY; Throughout the specification, Treacy uses MAY BE, as in : "- compound of formula I –MAY BE- formulated – " , and "Customary –adjuvants –may be- added - " (col. 6, bottom), meaning that in addition to the crop insects protected with compound Ia, as B , effects @ 0.1ppm in TABLE I , ants & termites may also be controlled. The instant " effective amounts " are thus effective not only for the tested species, but also for whatever other pest is present including ant,

termite, and cockroach in the case of public health pests. The claimed compounds, including that preferred, are applied to the same habitats of the same insects as are instantly claimed.

Appellant also argued a binary composition was taught in the prior art, & the effective amounts referred to the combination.

While appellants argue Treacy apply a binary composition that is synergistic, the fact is that the instant claim language is open, permitting of added actives. Further, Treacy apply the compounds in separate compositions, and show data with individual compound effects(B @ Table I,II). Treacy shows synergy permits use of effective lower doses (0.1,1 ppm), & treated the same habitats, & species, thus would have to been effective, particularly as efficacy as encompassed by the instant claims was not quantified.

II. Appellants characterize examiner's treatment of Stefferud's disclosure of household insects to include termites, powder post beetles, & others as controlled with the instant compounds by Takagi, as arguing for an insecticide effective on one insect as effective on all. Appellant's have stated that one would not know if a specific insecticide is effective for another pest of concern in a given location (page 11), but the instant claims are to thousands of insect species within the orders of claim 1.

The invoking of KSR by appellant's to require predictability is seen as met by the recognition that one in the art of concern would have had the expertise to apply the limited number of exemplified compounds in test against the limited number of

household insects in accord with the testing paradigms as shown by Takagi, with expectation of success in determining optimum concentrations effective to control powder post beetles & other household insect pests.

As to the declaration, the compounds of Takagi were argued as unsuited for testing as to the instant claimed methods of application, & would have only incidentally resulted in control, not inherently. However, the favored, or exemplified instant compound was not compared with the compounds of examples, inclusive of example 14 compound of Takagi, at once a reasonable selection by one of ordinary skill in the art, of compounds to be tested as a means of determining the optimal dose to apply to insects or their habitats, as was recognized at KSR to be within the skill of one in the art.

III. The arguments are moot, as Treacy, stated to be commonly owned at time of filing of the instant application in the US, after 11/29/99, is not available as an obviousness rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/NEIL LEVY/

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